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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

CHAU-0101US

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on March 27, 2008Signature Roger N. ChauzaTyped or printed name Roger N. Chauza

Application Number

10/686,915

Filed

Oct. 16, 2003

First Named Inventor

Roger N. Chauza

Art Unit

3747

Examiner

McMahon, Marguerite

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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10/686,915



REQUEST FOR REVIEW

Issues to be Reviewed

1. Whether independent claims 1, 26 and 27 are obvious over the Parker reference in view of the Saito et al reference, in that is there a motivation for combining the teachings of the cited prior art, and even if the teachings of the cited prior art can be combined, is the invention of independent claims 1, 26 and 27 made obvious.

2. Whether a prima facie case of obviousness has been established with respect to dependent claim 7, in that the Examiner has not indicated where in the prior art the use of a valve for switching fuel would make the invention of claim 7 obvious.

REQUEST 1

Issue 1 - Whether independent claims 1, 26 and 27 are obvious over the Parker reference in view of the Saito et al reference, in that is there a motivation for combining the teachings of the cited prior art, and even if the teachings of the cited prior art can be combined, is the invention of independent claims 1, 26 and 27 made obvious.

Claims 1, 26 and 27 specify in one form or another an engine performance demonstration unit that generally includes a "switch mechanism" for switching said aftermarket apparatus into operation and out of operation while said engine is running to thereby affect said engine.

In the Final Office Action mailed November 28, 2007, in the paragraph bridging pages 2 and 3 thereof, the Examiner has rejected claim 1 as being obvious as the Parker reference shows the mobile carrier, the engine mounted thereto, and aftermarket apparatus 10 to modify the properties of the fuel. The aftermarket apparatus is stated to be the magnets 15 and 20 of the

Parker reference. It is further stated that the Saito reference teaches a switch for switching the aftermarket apparatus 4 (the heating coil of the fuel injector) into and out of operation while the engine is running. The Examiner concludes that it would have been obvious to modify the Parker reference by substituting electromagnets for the permanent magnets, since the two are art-recognized equivalents, and by providing a switch which allows the aftermarket apparatus to be switched into and out of operation while the engine is running.

The Examiner did not appreciate or understand the prior art cited in the rejection of the claims. The Parker reference employs a permanent magnet so that the South pole is adjacent the pipe (col. 3, lines 20-23). By using a permanent magnet, the South magnetic field will influence the polarization of the molecules of fuel, as such molecules may be positive or negative (col. 1, lines 18-35 and col. 2., lines 22-26). The use of a permanent magnet is thus necessary for the Parker fuel cell. See also the previously-cited Adams et al patent 5,637,226 which is a magnetic fluid treatment device that requires the use of permanent magnets. In the Adams et al., reference, it is again noted that the use of a South pole of a permanent magnet provides better performance (col. 3, lines 18-22).

If an electromagnet of the type suggested by the Saito et al reference were used in the Parker fuel cell (instead of permanent magnets), together with the high frequency alternating current as also suggested by the Saito et al reference, then the alternating magnetic field with alternating North and South poles would undo any effect that would otherwise be achieved with a permanent magnet where the magnetic field does not vary in polarity. It should be understood that the Saito et al reference uses a high frequency alternating current to heat the fuel, as such type of currents produce eddy currents in the fuel tube to heat the tube and the fuel carried therethrough. There is no suggestion in the Saito et al reference that the alternating magnetic field does anything other than heat the fuel, in contrast to magnetically influencing the molecules of the fuel itself as taught by the Parker reference.

As an additional reason that the suggested combination lacks motivation, is that one skilled in the art would not be motivated to discard a permanent magnet, which produces a free

and permanent source of magnetic energy, for an electromagnetic magnet which requires a coil of wire wrapped around a core, a source of electrical energy to drive the coil, and wires to connect the coil to the energy source. With the importance of energy conservation, one skilled in the art would opt for the free energy source over a system where an external energy source would have to be provided every time the device were to be energized, which choice would be contrary to any principle of conservation of energy. In order to conserve energy with the combination suggested by the Examiner, the external energy source would have to be shut off, in which event the fuel to be treated would not be influenced by any magnetic field. The advantage of using a permanent magnet, which is a necessary condition to the magnetic treatment of fuel, would override any illusory “flexibility” suggested by the Examiner as a motivation by one skilled in the art.

While in certain situations, a permanent magnet and an electromagnet might be equivalents, such as for attracting metals, these two magnetic field sources are not equivalent in the instant situation. A metal by itself is not polarized and thus will be attracted to either a magnetic North pole or a magnetic South pole. This is apparently not the case with molecules of a carbon-based fuel, as taught by the cited references of record. Thus, the Examiner’s broad brush conclusion of obviousness based on the view set forth in the Final Office Action is unfounded and does not form a valid basis for obviousness.

From the foregoing, it is believed that there would be no motivation of one skilled in the art to modify the Parker reference by substituting electromagnets for the permanent magnets, when the result would not function for its intended purpose. Stated another way, the evidence of record in the very references cited by the Examiner, shows that the suggested substitution would result in a fuel cell that would not work at all. As such, the motivation to combine the teachings to achieve a device that would not work would only be suggested in an attempt to establish obviousness, but would not be employed by one skilled in the art according to the law of obviousness.

It is requested that the rejection of claims 1, 26 and 27 be reviewed and withdrawn.

REQUEST 2

Issue 2 -Whether a prima facie case of obviousness has been established with respect to dependent claim 7, in that the Examiner has not indicated where in the prior art the use of a valve for switching fuel would make the invention of claim 7 obvious.

Claim 7 is a dependent claim which specifies that the switch mechanism of claim 1 comprises a valve for switching fuel. Thus, when read in conjunction with claim 1, the valve for switching fuel is capable of switching the aftermarket apparatus into operation and out of operation while the engine is running.

Applicants have read the Final Office Action very carefully and have not found any language where the prior art has been applied to claim 7. According to established principles of patentability, the burden of proof of unpatentability of a claim is on the United States Patent and Trademark Office, and particularly on the examiner in charge of examination the application. Here, the Examiner has rejected claim 7 and has not provided any evidence of obviousness. The Rules do not condone the simple citing of prior art to an applicant, and leaving it to the applicant to figure out where the evidence of obviousness exists. This would otherwise place the burden on the applicant to first prove patentability so that the examiner could later challenge the applicant's conclusion. As noted in MPEP §706, "The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity."

In the instant situation, the Examiner has not only not clearly articulated a reason of unpatentability of claim 7, but has completely failed to articulate any reason whatsoever for unpatentability of such claim.

It is requested that the rejection of claim 7 be reviewed and withdrawn.